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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/540,648	03/31/2000	Paul G. Skuriat	20558-011	1725
30623	7590	10/18/2005	EXAMINER	
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. ONE FINANCIAL CENTER BOSTON, MA 02111			COLBERT, ELLA	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/540,648	Applicant(s) SKURIAT ET AL.	
	Examiner Ella Colbert	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

FA

### **DETAILED ACTION**

1. Claims 1-8 and 10 are pending. Claims 1 and 10 have been amended in this communication filed 08/01/05 entered as Response After Non-Final Action.
2. The 35 U.S.C. 112, second paragraph rejection for claim 1 has been overcome by Applicants' amendment to the claim and is hereby withdrawn.

### ***Claim Objections***

3. The Claim Objection to claim 10 has been overcome by Applicants' amendment to claim 10 and is hereby withdrawn.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by (US 5,297,031) Gutterman et al.

As per claim 1, Gutterman teaches, A system providing a measure of performance of participants to a trade management process, said trade management process including transmitting trade-related information between said participants, said system comprising: trade management processing means for receiving at least two communications, at least the second of which is from a first participant to said trade management process, each communication representing completion of a step in a trade (col. 2, lines 44-59); recording means for recording time- of- completion information

including at least one time- of -completion value representative of a time for completing at least the second of the steps measured from a start time, wherein the time -of -completion value is recorded when the second of said communications is received by said trade management processing means (col. 2, line 60-col. 3, line 67 and col. 5, lines 21-48); and performance processing means for generating a measure of performance with respect to said first participant as a function of said time -of -completion information the measure of performance being a function of the time elapsed between the completion of steps in the trade management process (col. 4, lines 6-52 and col. 7, line 59 –col. 8, line 66).

As per claim 2, Gutterman teaches, A system according to claim 1 wherein said trade management processing means receives a plurality of communications from a said first participant to said trade management process (col. 9, lines 3-25); said recording means records time information including at least one time value representative of a time when at least two of said plurality of communications is received by said trade management processing means (col. 10, line 60-col. 11, line 68); and said performance processing means generates a measure of performance with respect to said first participant as a function of said time information for said at least two of said plurality of communications received by said trade management processing means (col. 12, lines 1-56).

As per claim 3, Gutterman teaches, A system according to claim 1 wherein said trade management processing means receives a second communication from a second participant to a second trade management process (col. 13, lines 27-46); said

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recording means records time information including at least one time value representative of a time when said communication is received by said trade management processing means (col. 13, line 47-col. 14, line 24); and said performance processing means generates a measure of performance of said second participant with respect to said first participant as a function of said time information (col. 14, lines 25-51).

As per claim 4, Gutterman teaches, A system according to claim 1 wherein said trade management processing means receives a second communication from a second participant to a second trade management process (col. 13, lines 27-46); said recording means records time information including at least one time value representative of a time when said second communication is received by said trade management processing means (col. 13, 47-col. 14, line 24); and said performance processing means generates a measure of performance of said second participant with respect to said first participant as a function of said time information (col. 14, lines 25-51).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 5-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6247,000) Hawkins et al, hereafter Hawkins in view of (US 5,297,031) Gutterman et al, hereafter Gutterman.

As per claim 5, Hawkins teaches, A system providing a measure of performance of participants to a trade management process, said trade management process including transmitting trade-related information between said participants, said system comprising: a trade management system coupled to a network and adapted for receiving a first communication from a first participant to said trade management process (col. 8, line 64-col. 9, line 9, and fig.1). Hawkins failed to teach, a communication recording system coupled to said trade management system and adapted for recording time information including at least one time value representative

of a time when said first communication is received by said trade management system and an information processing system coupled to said trade management system and adapted for generating a measure of performance with respect to said first participant as a function of said time information. Gutterman teaches, a communication recording system coupled to said trade management system and adapted for recording time information including at least one time value representative of time when said first communication is received by said trade management system (col. 13, line 47-col. 14, line 24); and an information processing system coupled to said trade management system and adapted for generating a measure of performance with respect to said first participant as a function of said time information for said at least two of said plurality of communications received by said trade management system (col. 14, lines 25-51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a communication recording system coupled to said trade management system and adapted for recording time information including at least one time value representative of time when said first communication is received by said trade management system and an information processing system coupled to said trade management system and adapted for generating a measure of performance with respect to said first participant as a function of said time information for said at least two of said plurality of communications received by said trade management system and to modify in Hawkins because such a modification would allow Hawkins to have information that could identify the order and the trader's account number and any special instructions.

As per claim 6, Gutterman teaches, A system according to claim 5 wherein said trade management system is adapted to receive a plurality of communications from a said first participant to said trade management process (col. 9, lines 3-25); said communication recording system is adapted for recording time information including at least one time value representative of a time when at least two of said plurality of communications is received by said trade management system (col. 10, line 60-col. 11, line 68); and said information processing system is adapted for generating a measure of performance with respect to said first participant as a function of said time information for said at least two of said plurality of communications received by said trade management system (col. 12, lines 1-56)

As per claim 7, Gutterman teaches, A system according to claim 5 wherein said trade management system is adapted to receive a second communication from a second participant to a second trade management process (col. 13, lines 27-46); said recording system is adapted for recording time information including at least one time value representative of a time when said communication is received by said trade management system (col. 13, line 47-col. 14, line 24); said information processing system is adapted for generating a measure of performance of said second participant with respect to said first participant as a function of said time information (col. 14, lines 25-51).

As per claim 8, Gutterman teaches, A system according to claim 5 wherein said trade management system is adapted to receive a second communication from a second participant to said trade management process (col. 13, lines 27-46);



said information recording system is adapted for recording time information including at least one time value representative of a time when said second communication is received by said trade management system (col. 13, line 47-col. 14, line 24); and said information processing system is adapted for generating a measure of performance of said first participant and a measure of performance of said participant as a function of said time information (col. 14, lines 25-51).

As per claim 10, Hawkins teaches, A method of providing a measure of performance of participants to a trade management process, said trade management process including transmitting trade-related communications between said participants, said method comprising the steps of: providing a trade management system adapted for receiving said trade-related communications sent between said participants (col. 8, line 64-col. 9, line 9, and fig. 1). Hawkins failed to teach, receiving a first communication from a first participant to said trade management process; receiving a second communication from the first participant or from a second participant to said trade management process; recording time information including at least one time value representative of the times when said first communication and when second communication are received by said trade management system; and generating a measure of performance with respect to said first participant as a function of the time elapsed between the first communication and the second communication. Gutterman teaches, receiving a first communication from a first participant to said trade management process (col. 2, lines 44-59); recording time information including at least one time value representative of the times when said first communication and when

second communication are received by said trade management system (col. 13, line 47- col. 14, line 24); receiving a second communication from the first participant or from a second participant to said trade management process (col. 2, line 60- col. 3, line 3); and generating a measure of performance with respect to said first participant as a function of the time elapsed between the first communication and the second communication (col. 14, lines 25-51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to receive a first communication from a first participant to said trade management process; receive a second communication from the first participant or from a second participant to said trade management process; record time information including at least one time value representative of the times when said first communication and when second communication are received by said trade management system; and generate a measure of performance with respect to said first participant as a function of the time elapsed between the first communication and the second communication and to modify in Hawkins because such a modification would allow Hawkins to have information that could identify the order and the trader's account number and any special instructions.

### ***Response to Arguments***

10. Applicants' arguments filed 08/01/05 have been fully considered but they are not persuasive.

Issue no. 1: Applicants' argue: There is no apparent disclosure of Gutterman et al. of "performance processing means that generate a measure of performance as a function of the time elapsed between steps in the process" has been considered but is

not persuasive. Response: Applicants' are arguing the amendment to the claim.

However, a timestamp can time stamp an elapse of time between steps.

Issue no. 2: Applicants' argue: Applicants' respectfully submit that not disclosure, suggestion or motivation for an information processing system adapted for generating a measure of performance can be found in Gutterman et al and Hawkins et al fails to disclose, suggest or motivate providing an information processing system adapted for generating a measure of performance has been considered but is not persuasive. Response: Gutterman is interpreted as teaching a trade processing means including trade management for receiving a first communication in col. 2, lines 44-69 and teaches a trading system with a network for communication and a communication to a trader in col. 10, lines 42-59. Therefore, it is interpreted that Gutterman et al. and Hawkins et al. disclose an information processing system adapted for generating a measure of performance.

Conclusion: The Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

#### >CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969). The court determined that to read a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim. "The court found

that applicant was advocating the latter, e.g., the impermissible importation of subject matter from the specification into the claim.).<

Applicants' are respectfully requested to point out to the Examiner and to distinctly claim that which is considered to be the inventive concept in the claims and in the claim language.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Inquiries***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Tuesday-Thursday, 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**E. Colbert**  
**Primary Examiner**  
October 14, 2005